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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/625,598	07/24/2003	Koji Tanabe	2003_0854A	7943
513	7590	04/14/2005	EXAMINER	
WENDEROTH, LIND & PONACK, L.L.P.			STEIN, STEPHEN J	
2033 K STREET N. W.			ART UNIT	
SUITE 800			PAPER NUMBER	
WASHINGTON, DC 20006-1021			1775	

DATE MAILED: 04/14/2005

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary

Application No.

10/625,598

Applicant(s)

TANABE, KOJI

Examiner

Stephen J. Stein

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-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 21 January 2005.
- 2a) ☒ This action is **FINAL**. 2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 5-17 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☒ Claim(s) 5-7 is/are allowed.
- 6) ☒ Claim(s) 8, 10-13 and 15-17 is/are rejected.
- 7) ☒ Claim(s) 9 and 14 is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☒ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☒ All b) ☐ Some * c) ☐ None of:
- 1) ☒ Certified copies of the priority documents have been received.
 - 2) ☐ Certified copies of the priority documents have been received in Application No. _____.
 - 3) ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- | | |
|--|---|
| 1) <input type="checkbox"/> Notice of References Cited (PTO-892) | 4) <input type="checkbox"/> Interview Summary (PTO-413)
Paper No(s)/Mail Date. _____ |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948) | 5) <input type="checkbox"/> Notice of Informal Patent Application (PTO-152) |
| 3) <input type="checkbox"/> Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)
Paper No(s)/Mail Date _____ | 6) <input type="checkbox"/> Other: _____ |

DETAILED ACTION

1. The text of those sections of Title 35, U.S. Code not included in this action can be found in a prior Office action.

Claim Rejections - 35 USC § 102

2. Claims 8, 10-13 and 15-17 are rejected under 35 U.S.C. 102(e) as being anticipated by US 6,507,337 (Sato et al.).

Sato teaches a touch panel as part of an apparatus such as a PDA, comprising a first light transmitting sheet (20) comprising a first electrical conductive layer comprising a conductive metal oxide (25), a conductive layer forming member (23) comprising a polycarbonate base resin (first light transmitting layer), a bond layer made of a rubber base adhesive (27) (rubber elastic layer adhesive) and a supporting member (22) made of a glass substrate or transparent sheet (second light transmitting film) which comprises a hard coat layer (21) on the opposite side (See figure 2 and col. 9, lines 10-13, col. 8, lines 52-56 and column 7, lines 37-47). Sato further teaches that the first light transmitting sheet (20) is stuck to a second light transmitting layer (10) (light transmitting substrate) where the second light transmitting sheet has a second electrical conductive layer (14) and wherein the first light transmitting sheet confronts the second electrical conductive layer at a predetermined distance (See Figure 2). Sato still further teaches that the thickness of the conductive layer forming member (first light transmitting layer) is 100 microns (See column 10, lines 34-41).

Allowable Subject Matter

3. Claims 9 and 14 are objected to as being dependent upon a rejected base claim, but would be allowable if rewritten in independent form including all of the limitations of the base claim and any intervening claims.

4. Claims 5-7 are allowed over the prior art of record.

5. The following is a statement of reasons for the indication of allowable subject matter:

The prior art of record fails to teach or suggest the claimed transparent touch panel wherein the adhesive layer is made of a silicone rubber having: a) hardness of 10-70 (condition of measurement: scale A of Rockwell hardness test in Japanese Industrial Standards); b) a compressive permanent distortion factor of 50 % or less (condition of measurement: 70 degrees C 22 hours of B method in American Society for Testing and Material); c) total light transmittance of 90% or more; and d) a thickness of 5 gm or more.

Response to Arguments

6. Applicant has cancelled all previously pending claims 1-4 and drafted new claims 5-17 in which claims 5-7 incorporated the limitation of previous dependent claim 2 previously indicated as allowable. Claims 5-7 have therefore been indicated as allowed. Applicant has also drafted new independent claims 8 and 13 which included the limitation “ a light transmitting sheet *to be pressed by a user...*” and argue that in the Sato reference, the touch substrate 10 rather than the display substrate 20 is to be pressed by the user and therefore independent claims 8 and 13 are patentable over the Sato reference.

This argument has been considered, but not deemed persuasive. The newly added limitation “to be pressed by a user” is merely intended use and does not provide a patentable

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distinction over the prior art. The structure of the display substrate 20 disclosed in the Sato reference meets all the structural limitations of applicant's claims. The claims therefore remain rejected over the prior art of record.

Conclusion

7. **THIS ACTION IS MADE FINAL.** Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire THREE MONTHS from the mailing date of this action. In the event a first reply is filed within TWO MONTHS of the mailing date of this final action and the advisory action is not mailed until after the end of the THREE-MONTH shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the mailing date of this final action.

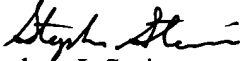
Any inquiry concerning this communication or earlier communications from the examiner should be directed to Stephen Stein whose telephone number is 571-272-1544. The examiner can normally be reached on Monday through Friday from 8:30 a.m. to 5:00 p.m. If the attempts to reach the examiner are unsuccessful, the examiner's supervisor, Deborah Jones can be reached by dialing 571-272-1535. The official fax number is 703-872-9306.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished

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applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).

April 7, 2005



Stephen J. Stein
Primary Examiner
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